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OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re White Palace, Inc.

Serial No. 76601030

Thomas I. Rozsa of Rozsa Law Group LC for White Palace,  
Inc.

Brian Pino, Trademark Examining Attorney, Law Office 114  
(K. Margaret Le, Managing Attorney).

Before Bucher, Grendel and Kuhlke, Administrative Trademark  
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register  
of the mark **5TH ELEMENT** (in standard character form) for  
goods identified in the application as:

Men's and boy's wearing apparel, namely, t-shirts, sweatshirts, tank tops, woven shirts, sweaters, cardigans, vests, jackets, pants, sweatpants, jeans, shorts, hats, caps, coats, scarves, neckerchiefs, neck bands, wrist bands, head bands, gloves, belts, pajamas, shoes, socks, underwear, swim wear, and trunks; and women's and girl's wearing apparel, namely, t-shirts,

sweatshirts, tank tops, woven shirts, sweaters, cardigans, vests, jackets, pants, sweatpants, jeans, shorts, hats, caps, coats, belts, scarves, neckerchiefs, neck bands, wrist bands, head bands, gloves, pajamas, shoes, socks, underwear, foundations, pantyhose, teddies, bras, skirts, dresses, blouses, swim wear, and bikinis.<sup>1</sup>

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the mark, as applied to the identified goods, so resembles the mark **3RD ELEMENT**, previously registered on the Principal Register (in standard character form) for goods identified in the registration as "waterproof, windproof, water-shedding, moisture-transmitting, and breathable clothing, namely, shirts, pullovers, salopettes, balaclavas, caps, jackets, vests, gaiters, and trousers, all of the foregoing being used for outdoor activities such as walking, climbing, and skiing; and belts, footwear, caps, and hats."<sup>2</sup>

Applicant and the Trademark Examining Attorney have filed main appeal briefs. No reply brief was filed, and no oral hearing was requested. We affirm the refusal to register.

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<sup>1</sup> Serial No. 76601030, filed on July 6, 2004. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

<sup>2</sup> Registration No. 2807733, issued on January 27, 2004.

Initially, we sustain the Trademark Examining Attorney's objection to the evidence (purporting to show third-party applications and registrations of ELEMENT marks for clothing), submitted by applicant for the first time with its appeal brief. This evidence clearly is untimely, and we have given it no consideration. See Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). In any event, as the Trademark Examining Attorney advised applicant in his final Office action, printouts from the databases of commercial search firms are not acceptable as evidence of third-party registrations. See *In re Dos Padres, Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 n.2 (TTAB 1994); and TBMP §1208.02 (2d ed. rev. 2004). The evidence attached to applicant's appeal brief therefore is faulty for this additional reason, as is the commercial search report evidence submitted by applicant with its response to the first Office action. We have given this evidence no consideration.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See

*In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the second *du Pont* factor, i.e., the similarity or dissimilarity of the goods as identified in applicant's application and in the cited registration, respectively. It is settled that it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods. See *In re Martin's Famous Pastry*

*Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

We find that certain of applicant's goods, i.e., "belts," "caps" and "hats," are identical to the "belts," "caps" and "hats" listed after the semicolon in the cited registration's identification of goods. We further find that the "shirts," "caps", "jackets," and "trousers" described in the cited registration as being "waterproof, windproof, water-shedding, moisture transmitting, and breathable" and as being "used for outdoor activities such as walking, climbing, and skiing," are encompassed by and legally identical to many of the items broadly described as "wearing apparel" in applicant's identification of goods, i.e., to the various types of "shirts," the "jeans" and "pants," the "jackets," and the "caps." Applicant's goods as identified in the application are not limited as to their composition, purpose or function, and they therefore must be presumed to include the more specialized type of clothing identified in the registration. Certainly, many of the apparel items identified in applicant's application could be "used for outdoor activities such as walking,

climbing, and skiing," and they therefore are similar to and complementary to registrant's goods to that extent.

We conclude that applicant's goods are similar rather than dissimilar to registrant's goods, and indeed that they are legally identical in many particulars. The second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Under the third *du Pont* factor (similarity or dissimilarity of trade channels), we find that applicant's goods as identified in the application would be marketed in the same trade channels and to the same classes of purchasers as registrant's goods. This certainly is so as to the goods which are identical, but is also true with respect to the non-identical goods. Registrant's outdoor-sports clothing items would not be sold solely in specialized sporting goods or outdoors stores; skiwear and walking/hiking clothes also would be available in department stores, for example. Also, nothing would preclude applicant's more generalized clothing items from being marketed in the specialized sporting goods or outdoors stores in which registrant's goods also might appear. The third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Under the fourth *du Pont* factor (conditions of purchase), we find that both applicant's goods and registrant's goods are products which would be purchased by ordinary consumers without necessarily a great deal of care or sophistication. Many of the goods are inexpensive items. The fourth *du Pont* factor weighs in favor of a finding of likelihood of confusion.

We turn finally to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of applicant's mark and the cited registered mark when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, in cases such as this, where the applicant's goods are identical (in part) to the goods of the cited registration, the degree of similarity

between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

5TH ELEMENT and 3RD ELEMENT are not identical. However, viewing the marks in their entireties in terms of appearance, sound, connotation and overall commercial impression, we find that they are highly similar. Both marks consist entirely of an ordinal number followed by the word ELEMENT. The overall similarity between the marks which results from this identical and arbitrary construction, i.e., an ordinal number followed by ELEMENT, far outweighs any dissimilarity resulting from the difference in the ordinal numbers themselves. Especially as applied to the identical and/or highly related goods at issue here, we find that applicant's mark and the cited registered mark are sufficiently similar to result in a likelihood of confusion. The first *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

Viewing all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that a likelihood of confusion exists. To the extent that any



doubts might exist as to the correctness of this conclusion, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: The refusal to register is affirmed.